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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,727	12/05/2003	Mark E. Herrmann	R0586-701110	1722

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EXAMINER	
LEE, BENJAMIN WILLIAM	
ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
06/02/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/728,727	HERRMANN ET AL.	
	Examiner	Art Unit	
	Benjamin W. Lee	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01/16/2008; 03/14/2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03/14/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/16/2008 has been entered. Claims 1-35 are pending in this application. Claims 1-7, 9, 12, 13, 15, 16, and 25 have been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 5-8, 11, 25-28, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metke (US 6,565,435 B2).

Re claim 1: Metke discloses a method for conducting a game, the method comprising acts of providing a primary method of entry of at least one player in the game (non-free play, inherent for video arcades, see col. 1, lines 13-24); providing, to the at least one player, an alternative method of entry (AMOE) to the game (free play or free entry, see col. 1, lines 51-67); and executing the game for the at least one player (see step 110 in Fig. 2).

However, Metke fails to explicitly disclose that the game is a wagering game.

OFFICIAL NOTICE is taken that both the concept and advantages of wagering games are old and well known in the art. Wagering games are known to appeal to people who enjoy gambling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement game of Metke with a wagering game since such a modification is a simple substitution of one known element for another to obtain predictable results.

Re claim 25: The teachings of Metke as applied to claim 1 above have been discussed. Metke further discloses a computer-readable medium storing instructions to perform the method of claim 1. The game machine and free-play system are computerized and thus inherently includes a computer-readable medium storing instructions (see Fig. 2; col. 2, lines 10-52).

However, Metke fails to explicitly disclose that the game is a wagering game.

OFFICIAL NOTICE is taken that both the concept and advantages of wagering games are old and well known in the art. Wagering games are known to appeal to people who enjoy gambling. Therefore, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to replace the amusement game of Metke with a wagering game since such a modification is a simple substitution of one known element for another to obtain predictable results.

Re claims 5 and 34: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses the free play system is directed towards tournaments (see col. 1, lines 25-38) which implies the games are games of skill and thus have non-fixed odds of winning the game.

Re claims 6 and 26: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses an act of conducting the game over a communication network (see col. 2, lines 20-29).

Re claims 7 and 27: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses the act of providing entry of the at least one player in the game includes an act of entering the at least one player in a game session following a processing of an entry request of the at least one player by the alternative method of entry (AMOE). The player is entered by free-play after the authorization is transmitted (see col. 2, lines 53-65).

Re claims 8 and 28: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses an act of providing to the at least one player an

indication of a game session to be entered by the alternative method of entry (AMOE). The player is disclosed to be physically located at the game unit and thus will know which game session will be entered (see col. 2, lines 53-65).

Re claims 11 and 35: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses the act of providing for the alternative method of entry (AMOE) includes providing for an entry of the at least one player in at least two game sessions (see col. 1, lines 31-34: "Generally speaking, in order to play in a tournament, the player may play one or more rounds…").

5. Claims 2, 4, 9, 10, 12-20, 22-24, 29-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metke in view of Itkis et al. (US 2003/0171986 A1, hereinafter Itkis).

Re claims 2, 4, 31, and 33: The teachings of Metke as applied to claims 1 and 25 above have been discussed.

However, Metke fails to explicitly disclose that the game is a wagering game of chance and the game has fixed odds of winning.

Itkis discloses a bingo game with a free method of entry. The game is a wagering game of chance (the winner is randomly selected, see ¶ [0013]) and the game has fixed odds (see ¶ [0032], lines 27-33).

Therefore, in view of Itkis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke with a bingo

wagering game of chance with fixed odds of winning in order to create a promotional event directed towards fans of bingo and gain a wider audience.

Re claims 9, 10, 29 and 30: The teachings of Metke as applied to claims 7 and 27 above have been discussed.

However, Metke fails to disclose executing the game for the at least one player further includes the acts of determining at least one game card for the at least one player, determining a winning pattern prior to a game session, drawing winning cell content from a predetermined set of cell content, determining whether the pattern of cell content on the game card matching the drawn winning cell content makes a pattern matching the winning patter, and if so, determining a payout based upon a fixed odds of winning.

Itkis discloses an act of conducting the wagering game of chance, the act of conducting further comprising acts of determining, for the at least one player, at least one game card having a pattern (10), determining, prior to a game session, a winning pattern (13), drawing winning cell content from a predetermined set of cell content (39 and 40), determining if, for the at least one player, whether the pattern of cell content on the game card matching the drawn winning cell content makes a pattern matching the winning pattern (39), and if so, determining payout (43) (see Figs. 1 and 2; paragraph [0020]; paragraph [0024]-[0026]). Itkis further discloses the act of determining the payout includes an act of determining the payout based upon a fixed odds of winning (see paragraph [0032], lines 27-33).

Therefore, in view of Itkis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke with a bingo game in order to appeal to fans of bingo and gain a wider audience.

Re claim 12: Metke discloses a game comprising a computer system, having a display through which a game player plays the wagering game (see col. 2, lines 53-65), a primary means of entry (non-free play, inherent for video arcades, see col. 1, lines 13-24) and an alternative means of entry (AMOE) (free play or free entry, see col. 1, lines 51-67), wherein the game player plays the wagering game through the use of the alternative method of entry (in tournament play, see col. 1, lines 51-67).

However, Metke fails to explicitly disclose that the game is a wagering game.

OFFICIAL NOTICE is taken that both the concept and advantages of wagering games are old and well known in the art. Wagering games are known to appeal to people who enjoy gambling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement game of Metke with a wagering game since such a modification is a simple substitution of one known element for another to obtain predictable results.

Re claims 13 and 14: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses the wagering game is available to be played on a communication network/Internet (see col. 2, lines 20-29).

Re claims 15 and 16: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses the AMOE is performed by an act of submitting an entry to the wagering game by mail and Internet/e-mail (see col. 2, lines 37-40).

Re claim 17: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses a game session associated with the wagering game is provided with an entry by AMOE (authorizing information provided by AMOE must be sent to the game unit, see col. 2, lines 53-65).

Re claim 18: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses a game session entered is the next starting game session after the AMOE is received and logged by the game operator. The authorization information may be instantly transmitted directly to the game unit, and thus the player will play in the next starting game session (see col. 2, lines 37-52).

Re claim 19: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses a game session entered is the next starting game session designated for AMOE game players after the AMOE is received and logged by the game operator. The request for free play/AMOE inherently designates the games the player requests as games for AMOE players.

Re claims 20 and 22: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Itkis further discloses a bingo game with a free method of entry. The game is a wagering game of chance (the winner is randomly selected, see ¶ [0013]) and the game has fixed odds (see ¶ [0032], lines 27-33).

Re claims 23: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses the wagering game has non-fixed odds of winning the game. Metke further discloses the free play system is directed towards tournaments (see col. 1, lines 25-38) which implies the games are games of skill and thus have non-fixed odds of winning the game.

Re claim 24: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses entry of the at least one player in at least two game sessions (see col. 1, lines 31-34: "Generally speaking, in order to play in a tournament, the player may play one or more rounds…").

6. Claims 3 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metke in view of Langan (US 5,782,470).

The teachings of Metke as applied to claims 1 and 25 above have been discussed.

However, Metke fails to explicitly disclose the game is a wagering game of skill.

Langan teaches a wagering game of skill in which the outcome of the game is dependent upon the ability of the player in predicting the real-life performance of selected professional sports players (see col. 4, lines 5-14).

Therefore, in view of Langan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke with the wagering game of skill of Langan in order to attract players that are interested in sports-themed games and gain a wider audience.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Metke as modified by Itkis as applied to claim 12 above, and further in view of Langan.

The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed.

However, Metke and Itkis fail to explicitly disclose the game is a wagering game of skill.

Langan teaches a wagering game of skill in which the outcome of the game is dependent upon the ability of the player in predicting the real-life performance of selected professional sports players (see col. 4, lines 5-14).

Therefore, in view of Langan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke as modified by Itkis with the wagering game of skill of Langan in order to attract players that are interested in sports-themed games and gain a wider audience.

Response to Arguments

8. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

The applicant has amended the claims to specifically cite that the game being entered is a wagering game. However, the examiner is of the opinion that wagering games are old and well known in the art and it would have been obvious to substitute any game into the invention of Metke with expected results (having free play in different games).

The applicant also argues that Itkis is legally precluded form selling bingo cards to patrons and thus would be improper to combine with Metke (Remarks, pages 11-12). The applicant also argues similarly regarding the combination of Metke and Langan (Remarks, page 13). Even assuming the applicant's argument is correct, it is noted that the features upon which applicant relies (i.e., wagering) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Although the claims now recite that the game must be a "wagering game", the claims do not require wagers to be placed. It is well known to be able to play wagering games without using actual wagers or money (e.g. computer versions of solitaire or blackjack). Thus, the game of Itkis may be combined with the system of Metke without violating any laws.

Furthermore, the examiner does not see how legality has any correlation with the obviousness of a combination. For example, assault rifles and grenade launchers are illegal in many areas. However, the mere fact that these weapons are illegal does not render it unobvious

to combine an assault rifle and grenade launcher together, or to combine either illegal weapon with a legal weapon (such as putting a bayonet on an assault rifle).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346. The examiner can normally be reached on Mon - Fri (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. W. L./
Examiner, Art Unit 3714

/Ronald Laneau/
Supervisory Patent Examiner, Art Unit 3714
05/27/08